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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/756,377	01/04/2001	Richard Hsiao	SJO9-2000-0093US1	6680

7590 02/20/2004

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EXAMINER

OMETZ, DAVID LOUIS

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 02/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/756,377

Applicant(s)

HSIAO ET AL.

Examiner

David L. Ometz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12-17 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8 is/are rejected.
- 7) ☒ Claim(s) 4-7 and 9-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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1. Applicant's election without traverse of species II, figures 5 and 6 in Paper No. 5 is acknowledged.
2. Claims 5, 9, 12 are objected to because of the following informalities: in claim 5, line 2, --the-- should be inserted before "magnetic"; in claim 9, last line, "sample" should be deleted; in claim 12, line 23, --the-- should be inserted before "second". Appropriate correction is required.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 457278.

As per claim 1, EP'278 shows in figure 2 a transducer for reading magnetic transitions from a moving magnetic material comprising: an air bearing surface (generally shown by 14) oriented in a first plane; a magnetic sensor 25; a magnetic shield 28 disposed along a second plane, the second plane being orthogonal to the first plane, the magnetic shield 28 having an area in the second plane; an electrically conductive shield 29 formed in a third plane which is parallel to the second plane, the electrically conductive shield 29 being electrically isolated from the first magnetic shield 28, the third plane being disposed so that the magnetic shield 28 is disposed between the electrically conductive shield 29 and the magnetic sensor 25; and a first contact pad 27A of conductive material in electrical contact with the electrically conductive shield.

As per claim 2, the transducer of claim 1 wherein the first contact pad 27A is disposed with a planar surface parallel to the third plane, the first contact pad 27A overlapping the electrically conductive shield 29, the transducer further comprising a via 33 electrically

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connecting the electrically conductive shield 29 to the first contact pad 27A in an overlapping area.

As per claim 3, the transducer of claim 1 further comprising a second contact pad 27B of conductive material electrically insulated from the electrically conductive shield 29 and in electrical contact with the magnetic sensor 25; and wherein the second contact pad 27B is disposed with a planar surface parallel to the third plane, the electrically conductive shield 29 extending to cover the first magnetic shield 28, the first contact pad 27A and the second contact pad 27B.

As per claim 8, EP'278 shows a transducer for reading magnetic transitions from a moving magnetic material comprising a plurality of layers disposed generally in parallel planes, the layers along a first cylindrical core orthogonal to the parallel planes comprising: a substrate 32; a first undercoat layer of electrically insulating material 24<sub>4</sub>; an electrically conductive shield 29 which is electrically connected to a first lead pad 27A; a second undercoat layer 24<sub>1</sub> of electrically insulating material; and a magnetic shield 28, the electrically conductive shield 29 being electrically insulated from the magnetic shield 28 and overlapping the magnetic shield 28 in an area orthogonal to the air bearing surface.

5. Claims 4-7, 9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 12-17 are allowed.

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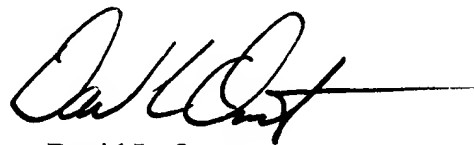
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited all show shielded thin film magnetic heads.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Ometz whose telephone number is (703) 308-1296.

The examiner can normally be reached on M-W, 6:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David L. Ometz  
Primary Examiner  
Art Unit 2653

DLO  
2/18/04